

In re Application of
diGirolamo et al.

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April 13, 2009

Date _____

Kathleen L. McDermott

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Sir:

PRE-APPEAL REVIEW REQUEST

The Patent Office is respectfully requested to conduct a pre-appeal brief review of this case.

Claims 1 and 35-39 as rejected are being obvious under §103 over Soucy in view of Pellock. The Examiner in this rejection reviews claim 1 and goes through a list of features that the Patent Office maintains is shown by Soucy. Then, the Patent Office states what Soucy lacks with respect to claim 1. This is followed by findings as to what the Patent Office maintains is disclosed by Pellock. Then, the analysis ends. There is no analysis that shows specifically how the Examiner proposes to modify Soucy to render the claimed invention. There is no reason given by the Patent Office with respect to claim 1 as to why a person of ordinary skill in the art would incorporate any of the teachings of Pellock into Soucy. The rejection does not

meet the requirements of §103, and certainly does not establish a *prima facie* case of obviousness.

In addition, for most of the rejections, the office action lacks clarity as to how the teachings of the secondary references are being applied and how they are used to modify the primary references. Throughout the rejections, the Patent Office fails to provide findings that are supported with technical underpinnings as to why a person of ordinary skill in the art would combine the various references.

In some instances, the Examiner proffers a motivation. For example, with respect to claim 7, it requires first and second projections where each projection includes a locking surface and a stop and wherein when interlocked the locking surface of each projection engages the stop of the other projection. The Patent Office acknowledges that Soucy does not show all the claimed features and then articulates some features of Cubbler that the Patent Office believes is taught by Cubbler. After this, the Patent Office, in conclusionary fashion, simply concludes that the claimed invention is obvious because to modify Soucy with alternative securing means of Cubbler would provide a more secure attachment between the adjacent spacers of Soucy. The Patent Office does not inform the Applicants as to how the tongue portions 42, for example, of Cubbler would be incorporated into the brace of Soucy. Applicant is faced with having to speculate how the Patent Office proposes the Cubbler teachings to be incorporated into the Soucy brace. As a consequence, it is difficult to even traverse the obviousness rejection.

Throughout the office action, the Patent Office attempts to find end flanges in Pellock. However, the structures identified by the Patent Office as “end flanges” in Pellock can, under no circumstances, be properly termed “end flanges.” It is unclear as to what claim construction the Patent Office is giving the claim term “end flange.” However, no reasonable construction of that term can be so broad as to encompass the structure of Pellock. A flange is a stiffening

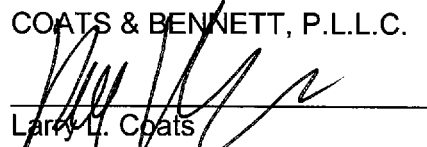
extension associated with a structure that is generally perpendicular to the structure from which it immediately extends. Applicants' specification clearly describes the end flange as extending normal to the spacer. An ordinarily skilled artisan in the field of light metal building construction would understand that a flange is a reinforcing structure extending normal from its intermediate parent structure as a side flange is to a channel beam, for example. The Patent Office asserts that the combination of edge portion 54 and ledge 56 together comprise an end flange in Pellock. Combined edge portion 54 and ledge 56 merely comprise a slightly angled edge that serves as a guide for guiding a truss core portion into a receiver in order to engage the Pellock truss brace with a truss structure.

Finally, throughout the office action, the obviousness rejections are not properly set forth. It is important that each claim be independently examined for obviousness and that each obviousness rejection be based on a claim-by-claim, limitation-by-limitation analysis. Otherwise, the Applicants cannot properly argue and traverse the obviousness rejections. This has not been done in this case, because as discussed above, the rejection of claim 1 based on obviousness and the patents to Soucy and Pellock fail, as a matter of law, because the rejection, like many others in the final office action, lack the most fundamental requirements of an obviousness rejection. That is, each claim should be analyzed for obviousness, and the obviousness analysis should include three essential factual determinations: (1) the difference between the claimed invention and the primary reference, (2) how the secondary reference teachings are to be incorporated into the primary reference, and (3) reasoning that goes beyond conclusionary statements and that has sound technical basis as to why an ordinarily skilled artisan would modify the primary reference in the first place.

Respectfully, the office action fails in making these three essential factual determinations for each claim and each rejection in the case.

Respectfully submitted,

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